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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,600	05/11/2001	Jouni Kivela	0365-0501P	5717

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EXAMINER

CHEUNG, WILLIAM K

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/831,600

Applicant(s)

KIVELA ET AL.

Examiner

William K. Cheung

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-25 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. In view of amendment filed February 3, 2006, claim 5 has been cancelled.

Claims 1, 3, 4, 6-25, 29 are pending.

2. In view of amendment filed February 3, 2006, the rejection of claims 1, 3, 8-20, 22-25, 29 under 35 U.S.C. 103(a) as being unpatentable over Bernier et al. (US 5,834,571) is withdrawn.

3. In view of the following rejection, the allowability of claims 4-7, 21 is withdrawn.

Claim Objections

4. Claims 1 and 9 are objected to because of the following informalities: Claims 1 and 9 are objected because they are identical claims. Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 3, 4, 6-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernier et al. (US 5,834,571) for the reasons adequately set forth from paragraph 6 of non-final office action of June 1, 2005, and further in view of de Lorenzo et al. (US 4,535,134).

Applicant's arguments filed September 1, 2005 have been fully considered but they are not persuasive. Applicants argue that the examiner fails to provide adequate motivation for the 103 rejection in view of Bernier et al. Further, applicants also argue that the *In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963) is pertained to a product that is not patentably distinguishable from the prior art. However, applicants fail

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to recognize that *In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963), the court held the claimed continuous operation would have been obvious in light of the batch process of the prior art.). With the teachings of *In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963), adequate motivation has been disclosed for converting a non-continuous process into a continuous one.

Set forth from paragraph 6 of non-final office action of June 1, 2005, the difference between the invention of claims 1, 3, 8-20, 22-25, 29 and Bernier et al. is that Bernier is silent on a process comprising a continuously operated control valve.

However, when comparing the process of Bernier et al. side by side with the instantly claimed process, both processes are substantially identical except for the claimed "continuous" feature of the claimed continuously operated control valve. In view of MPEP 2144.04, it would be considered obvious to one of ordinary skill in art to modify a non-continuous process into a continuous one.

MPEP 2144.04

V. MAKING PORTABLE, INTEGRAL, SEPARABLE, ADJUSTABLE, OR CONTINUOUS

A. Making Portable

In re Lindberg, 194 F.2d 732, 93 USPQ 23 (CCPA 1952) (Fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results.).

B. Making Integral

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In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice."); but see Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." Nortron argued that the invention is just making integral what had been made in four bolted pieces. The court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one- piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.).

C. Making Separable

In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

D. Making Adjustable

In re Stevens , 212 F.2d 197, 101 USPQ 284 (CCPA 1954) (Claims were directed to a handle for a fishing rod wherein the handle has a longitudinally adjustable finger hook, and the hand grip of the handle connects with the body portion by means of a universal joint. The court held that adjustability, where needed, is not a patentable advance, and because there was an art-recognized need for adjustment in a fishing rod, the substitution of a universal joint for the single pivot of the prior art would have been obvious.).

E. Making Continuous

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In re Dilnot, 319 F.2d 188, 138 USPQ 248 (CCPA 1963) (Claim directed to a method of producing a cementitious structure wherein a stable air foam is introduced into a slurry of cementitious material differed from the prior art only in requiring the addition of the foam to be continuous. The court held the claimed continuous operation would have been obvious in light of the batch process of the prior art.).

The difference between the invention of claims 1, 3, 4, 6-25, 29 and Bernier et al. is that Bernier et al. are silent on that the operation of the control valve is adjusted by using a control signal obtained from a bed level controller.

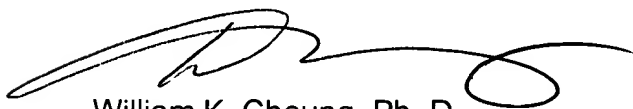
De Lorenzo et al. (abstract) disclose a method of preparing a polymer through a vapor phase polymerization reactor. Further, de Lorenzo et al. (col. 13, line 37 to col. 14, line 19; col. 14, line 50 to col. 16, line 47) disclose a process which involves a discharge rate of the polymer powder is adjusted by using a continuously operated control valve, and the operation of the control valve is adjusted by using a control signal obtained from a bed level controller. Therefore, motivated by the expectation of success of reducing vapor losses, outlet pluggage, and downtime on the reactor (abstract of De Lorenzo et al.), it would have been obvious to one of ordinary skill in art to incorporate the bed level controller teachings in De Lorenzo et al. into the gas phase polymerization method of Bernier et al. to obtain the invention of claims 1, 3, 4, 6-25, 29.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

February 11, 2006

**WILLIAM K. CHEUNG
PRIMARY EXAMINER**